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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,891	04/30/2001	Tetsuya Toshine	Q64332	1136

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EXAMINER

ANGEBRANNDT, MARTIN J

ART UNIT

PAPER NUMBER

1756

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,891

Applicant(s)

TOSHINE ET AL.

Examiner

Martin J Angebranndt

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant should state that the substrate is releasable/peelable by inserting --which is releasably adhered to, - - after "a substrate" in line 2 of claims 1 and 2. The current language is confusing as it seems to infer that the "volume hologram layer" of claim 1 or the "surface protective layer" of claim 2 are separable from the remainder of the laminate.

In claim 5, at line 3, after please replace "second with - - transparent--. to differentiate it from "a second heat seal layer" introduced in claim 1 and of which it is a part, but not the whole.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-6 and 8 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Ueda et al. '598.

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Ueda et al. '598 describe the laminate of figure 21, which comprise a peelable substrate (4), a hologram layer (2), an adhesive layer (55), a black light blocking layer (54) a second adhesive layer (56) and a removable substrate (53). (col. 18-19) Useful photopolymerizable volume holographic recording materials, such as omnidex-706 is disclosed. (13/13-15). The use of a colored transparent or opaque layer in place of the black layer, or the blackening/coloring of the adhesive layer itself is disclosed. (18/52-65).

6. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morii et al. '378.

Morii et al. '378 teach the laminate of figure 10b, which comprise a protective layer (7), an adhesive layer (5"), a hologram layer (6), a second adhesive layer (5'), a colored layer (9) a third adhesive layer (5) and a removable substrate (11) (illustrative example 5). Useful volume holographic recording materials are disclosed. (12/28-16/35). Useful adhesive layer materials include acrylic, acetate, gelatin, casein, polyvinyl acetate and hot melt resins. (12/7-27 and 33/49-65). The surface of the surface protective layer (7) may be provided with a release layer and a rigid film initially adhered to it and then peeled from it. (18/33-52). Figures 4 and 5 show the tearing of the holographic layer when delamination is attempted. The use of colored sheets as layer (9) is disclosed as providing a background color different from that of the hologram to enhance the contrast of the image. (26/46-57).

It would have been obvious to one skilled in the art to modify the invention of illustrative example 10b by providing the surface protective layer with a release layer and a peelable substrate based upon the disclosure to do so.). The relative softening points of the adhesive layers are inherent as the medium does not come apart when applied.

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7. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Ueda et al. '598 or Morii et al. '378, in view of Kushibiki et al. '285.

Kushibiki et al. '285 teach the provision of layer (5) which acts to provide a background color to the hologram and may be comprised of a metal or metal oxide (7/20-42).

It would have been obvious to one skilled in the art to modify the invention of figure 21 of Ueda et al. '598 or figure 10b, (illustrative example 5) of Morii et al. '378 by using a background of a metal or metal oxide as taught by Kushibiki et al. '285 for use with volume holograms in place of the red dyed layer with a reasonable expectation of achieving comparable results.

8. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Ueda et al. '598 or Morii et al. '378, combined with Kushibiki et al. '285, further in view of Kaule CA 2046711.

Kaule CA 2046711 teaches a holographic transfer film comprising a substrate (10), a separation layer (12), a protective film (14), an embossed layer (16), a metallic holographic layer (18), a protective layer (20) and an adhesive layer (22) and a peelable substrate (pages 5 and 6). The adhesive layer (22) may be colored black (page 6). The use of volume holographic materials, rather than embossed or relief holograms is disclosed. (page 6).

In addition to the basis provided above, it would have been obvious to modify the combination of either of Ueda et al. '598 or Morii et al. '378, with Kushibiki et al. '285 by coloring the lower adhesive layer, rather than have a separate color layer based upon the disclosure of equivalence by Kaule CA 2046711.

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9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hirukawa et al. '060 (abstract), Nakamichi et al. '525 (abstract) and Weber et al. '662 (8/25-39) describe barrier layer materials used to prevent migration of components from the adhesive layer into the hologram layer.

Danjo et al. JP 61-238079, Takeuchi et al. '857 (10/30-12/16), Kushibiki et al. JP 63-284587 and Kuwayama et al. JP 63-287988 describe the effect of a dyed layer adjacent to the holographic layer.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebranndt whose telephone number is 703-308-4397.

The examiner can normally be reached on Mondays-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Martin J Angebranndt
Primary Examiner
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4/30/03